

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on June 13, 2008, claims 1-16 and 18-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,295,064 (“Malec”) in view of U.S. Patent No. 5,264,822 (“Vogelman”) in further view of U.S. Patent No. 5,640,002 (“Ruppert”) and claim 17 was rejected under 35 U.S.C. 103(a) as being unpatentable over Malec in view of Vogelmann in further view of Ruppert in further view of MacIntyer. Accordingly, Applicant respectfully provides the following:

Rejections under 35 U.S.C. § 103(a):

M.P.E.P. § 2141 sets forth the *Graham* factual enquiries that should be considered when making an obviousness rejection under Section 103: 1) ascertaining the scope and content of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; and 3) resolving the level of ordinary skill in the pertinent art. (Citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).) In addition, M.P.E.P. §§ 2141 and 2142 set forth that “the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” (Citing *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. ___, 82 USPQ2d 1385 (2007).)

The M.P.E.P. provides several examples of rationales that can support a rejection under 35 U.S.C. § 103, namely:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

- (E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

(M.P.E.P. §§ 2141 & 2143, emphasis added.) As may be seen from the emphasized portions of the above potential rationales, each rationale is dependent on showing known elements from the prior art corresponding to the limitations of the claimed invention. Each rationale therefore depends on: 1) satisfying the *Graham* enquiry of showing that the scope and content of the prior art included each limitation contained in the claimed invention, and 2) satisfactorily showing that one of ordinary skill in the art would take the art teachings to overcome the identified differences under *Graham* between the claimed invention and the individual teachings of the prior art.

Therefore, for a rejection under Section 103 to stand, it must explicitly set forth 1) factual findings showing that each claim element was known in the art at the time of the invention, and 2) factual findings showing that one of ordinary skill in the art, at the time of the invention, would have found it obvious to modify or combine the teachings to arrive at the claimed invention. (See, for example, the enumerated required articulations set forth in M.P.E.P. § 2143 for each lettered rationale.)

Note that M.P.E.P. sections 2141 and 2142 set forth that the key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious; rejections on obviousness cannot be sustained by mere conclusory statements. (Citing *KSR*, 82 USPQ2d at 1396 & *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).) Thus, a rejection under Section 103 cannot stand if it contains a

mere statement that the claimed invention would have been obvious without explicitly enumerating the necessary factual findings.

Independent claim 1 provides for an electronic shopping cart display system comprising: a display unit having a display screen attached to a shopping cart for displaying information; one or more transceiver units for sending information to the display unit, said transceiver units located proximate to promoted items, wherein the information includes a visual message containing product-specific promotions; a transmitter in direct electronic communication with the transceiver unit, for sending information to the transceiver; an audible alert component on the display unit for signaling receipt of information from the transceiver unit; and a computer for operating the interaction between the display unit, the transceiver units, and the transmitter in direct electronic communication with the transmitter unit and in indirect electronic communication with the transceiver unit through the transmitter. These combinations of elements are not disclosed in the cited references.

In particular, none of the prior art systems teach a simple apparatus, which allows for complex, up-to-date product specific information to be transmitted to a communication device on a shopping cart. The art present prior to the current invention consisted either of very simple broadcasting systems, which repeatedly broadcast messages into transmission zones and allowed this simple broadcast to be received by consumers. For example, Vogelmann taught a system that allowed a simple audio broadcast to be received at a shopping cart within a given transmission zone. This allowed Vogelmann to transmit audio advertising messages to shopping carts while maintaining a simple apparatus on the shopping cart. By comparison, other systems existed in the market, which utilized more complex apparatus on the shopping cart. However, these systems are not cost effective and are difficult to maintain. For example, Malec teaches a system

that utilizes a complex cart mounted system containing a plethora of advertising messages and coupons wherein the entire process for presenting consumers with media/information resides with the cart and is merely triggered by trigger transmission as a cart moves through a shopping environment. Accordingly, prior art systems either consist of very simple on-board apparatus utilized to convey simple transmissions to shoppers or consist of expensive on-board apparatus used to store and display complex data. By contrast, the presently claimed invention comprises a simple, cart mounted apparatus, that allows for complex product specific information, subject to change over time, to be received at a cart by consumers in a shopping environment. The present invention utilizes a simple on board apparatus, but allows for the complex transfer of visual information.

Malec discovered the use of a complex on-board computing system utilized to store a plethora of visual messages, print coupons and scents to be dispersed at appropriate locations upon receipt of the appropriate signal from a trigger transmitter. Accordingly, the "Trigger Transmitters" taught in Malec transmit simple positional information which is used to trigger promotional information stored on the cart-mounted electronics. Malec, Column 8, Lines 52-56. By explicitly storing all promotional and/or other product-related information on the cart-mounted electronics, Malec teaches away from the transmission of promotional product specific to individual carts from the transceiver units as they traverse the shopping environment. Malec's trigger transmitters do not transmit any product-specific information for the user, but merely transmit location information; the display then searches in its memory for messages related to that location information for display. Col 8 lines 41-60. The trigger transmitters only serve as location beacons serving as signposts to tell the shoppers "You are here." Col 2 lines 29-36.

Accordingly, Malec's system relies on the installation of a complex and expensive computing system at each shopping cart.

Vogelman's system by contrast is simple, thus avoiding the cost prohibitive strategy taught in Malec, but that is incapable of transmitting complex, timely product specific information to individual shopping carts as they traverse a shopping environment. Volgelman discloses a simple system for broadcasting audio messages to shopping carts moving through a plurality of pre-defined spatial zones in a store. Vogelmann, Abstract. Volgelman selectively places transmitter's in particular geographic areas in a store. Each transmitter includes a single audio message and a transmitting means for sending a carrier signal over a predefined spatial zone. As a cart enters a zone the recorded message is broadcast to the cart while in the transmission zone. Volgelman, Column 3, lines 21-50. By storing only one prerecorded audio message, and by broadcasting the same non-interactive message to each cart that enters a zone Volgelman fails to teach the limitations found in the presently amended claim set.

Replacing the transmitter of Malec with the transceiver of Volgelman would not arrive at the claimed invention. Malec, in view of Vogelmann does not teach complex communication between the individual carts and the centrally-based store transmitter/transceiver, including the transmission of visual messages containing product specific information. To implement the present invention, the transceivers claimed serve a function of transmitting a visual message containing product-specific promotions and advertisements for display on the display unit. This information is complex, and is subject to change. The claimed transceivers are designed to receive additional information to update the product-specific information to be transmitted, and are thus in communication with the controlling computer and transmitter. The combination of Malec's trigger transmitters with Volgelman's audio broadcast system fail to achieve the same

result as the claimed transceivers, because they fail to allow for transmitting complex visual product specific promotions, advertisements and/or other product specific information from the control computer to the transceiver units, and then from the transceiver units to the display units located at individual carts. Rather, replacing the signal transmission of Malec with the audio broadcast of Vogelmann produces a simple audio broadcast system.

For at least these reasons, Applicant respectfully submits that claim 1 is not made obvious by the cited combination of references and therefore respectfully request removal of the rejection. Claims 2-23 depend from claim 1 and are allowable for at least the same reasons. Applicants therefore respectfully request removal of all remaining rejections.

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

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Respectfully submitted,



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